UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,825	12/07/2001	Yasuo Shibusawa	TMI-109	7759

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EXAMINER
SHRADER, LAWRENCE J

ART UNIT	PAPER NUMBER
2193	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	10/004,825	SHIBUSAWA ET AL.
Office Action Summary	Examiner	Art Unit	
	Lawrence Shrader	2193	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _22 December 2004_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-8_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-8_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☒ All   b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
             application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   Paper No(s)/Mail Date. _____.
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)   5) ☐ Notice of Informal Patent Application (PTO-152)
     Paper No(s)/Mail Date _____.   6) ☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to the amendment filed by the Applicant on 12/22/2004.

2.   Claims 1 – 8 remain rejected. Applicant's arguments with respect to claims 1 – 8 have

been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1, 2; 4 – 6; and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by

Smith et al., U.S. Patent 6.067,582 (hereinafter referred to as Smith).

In regard to claim 1:

A software installation method comprising the steps of:

"storing information related to a constituent element of a user's computer system and software required for the constituent element and also storing identification information for identifying a user's computer system that is supplied to the user's computer system, and system configuration information indicating hardware of the user's computer system;

accepting from the user's computer system the identification information of the user's computer system;

sending, to the user's computer system, software required for the constituent element the user's computer system that is determined from the stored system configuration information which corresponds to the accepted identification information. "

Smith discloses stored information related to an element of a computer system, and including computer system identification information and hardware configuration information (column 8, lines 23 – 31, and 61 – 65). After the system information is accepted, the software is sent to the user's computer system based on the stored informant previously sent (column 8, line 66 to column 9, line 4; e.g., see Figure 3).

In regard to claim 2, incorporating the rejection of claim 1:

"...further comprising the steps of:

> *managing, for an individual user, a fee for the software sent to the user's computer system; and*

> *collecting the fee from the user. "*

See column 8, line 66 to column 9, line 4; see also Figure 3.

In regard to claim 4:

A software installation method comprising the steps of:

"sending identification information of a first computer system to a second computer system;

accepting, in response to the above step, software required for a constituent element of the first computer system, which is indicated in system configuration information stored in the second computer which corresponds to the identification information sent from the first computer system; and

conducting setup processing in order to make the software accepted in the accepting step into an executable state in the first computer."

Smith discloses sending identification information from one computer to another, accepting the required software indicated by configuration information corresponding to the sent information (column 8, lines 23 – 31, and 61 – 65), and conducting a setup to make the software executable (e.g. Figure 3, step 90)

In regard to claim 5, incorporating the rejection of claim 4:

"...wherein the first computer system reads and executes a specified installation software which is stored in a specified storage medium."

See Smith column 8, lines 15 – 48.

In regard to claim 6, incorporating the rejection of claim 5:

"...further comprising the step of storing software which the first computer system receives from the second computer system."

See Smith Figure 3, step 90.

In regard to claim 7 (a storage medium): it is rejected for the same corresponding reasons put forth in the rejection of claim 4 (a corresponding method).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et

al., U.S. Patent 6.067,582 in view of Bakshi et al., U.S. Patent 6,574,663.

In regard to claim 3:

A software installation method comprising:

*"a first database for storing information related to a constituent element of a computer
system and software required for the constituent element;*

*a second database for storing identification information for identifying a computer
system supplied to a user, and system configuration information indicating hardware of
the computer system;*

*an accepting means for accepting from the user's computer system the identification
information given to the user's computer system;*

*first determining means for determining system configuration information which
corresponds to the accepted identification information, with reference to the second
database;*

*second determining means for determining software required for the constituent
element which is indicated in the system configuration information, with reference to
the first database; and*

sending means for sending the determined software to the user's computer system."

Smith discloses an accepting means to receive stored information related to an element of

a computer system, and including computer system identification information and hardware

configuration information, as well as a determining means for system configuration information

and a determining means for the required software (column 8, lines 16 – 53, and 61 – 65), but

Smith does not explicitly teach separate databases for storing information relating to elements of

a computer system and identifying software in the configuration. However, Bakshi discloses a

first database with device information and a second database with software information and combining the two in determining an operable system (Abstract; column 2, lines 1 – 7). Using two databases and combining the information to configure a system is analogous to the claimed invention. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the software updating system with the configuration and system element information as taught by Smith, and modified to have a first database for one element of information and another database for other configuration information as taught by Bakshi, because the combination provides a means to configure various devices with relevant software to attain desired attributes as taught by Bakshi at column 2, lines 34 – 42 increasing the flexibility to access multiple sources and increasing the chances of finding the best configuration.

In regard to claim 8 (a system):

> *means for storing identification information for identifying the first computer system;*
>
> *means for connecting the first computer system to the second computer system and for sending the identification information to the second computer system, in accordance with recovery instructions;*

Smith discloses an accepting means to receive stored information related to an element of a computer system, and including computer system identification information and hardware configuration information, as well as a determining means for system configuration information and a determining means for the required software (column 8, lines 16 – 53, and 61 – 65). Recovery procedures are taught ay column 8 lines 49 – 60.

> *first accepting means for accepting software sent from the second computer system, and wherein the second computer system comprises:*

a first database for storing information related to a constituent element of the first computer system and software required for the constituent element;

a second database for storing identification information for identifying a computer system supplied to a user, and system configuration information indicating hardware of the first computer system;

second accepting means for accepting, from the first computer system, the identification information of the first computer system;

accepting means for accepting the identification information sent from the first computer system;

first determining means for determining system configuration information which corresponds to the accepted identification information, with reference to the second database;

second determining means for determining software required for the constituent element which is indicated in the system configuration information, with reference to the first database; and

sending means for sending the determining detected software to the first computer system.

Smith discloses an accepting means to receive stored information related to an element of a computer system, and including computer system identification information and hardware configuration information, as well as a determining means for system configuration information and a determining means for the required software (column 8, lines 16 – 53, and 61 – 65), but Smith does not explicitly teach separate databases for storing information relating to elements of a computer system and identifying software in the configuration. However, Bakshi discloses a first database with device information and a second database with software information and combining the two in determining an operable system (Abstract; column 2, lines 1 – 7). Using two databases and combining the information to configure a system is analogous to the claimed

invention. Therefore, it would have been obvious to one skilled in the art at the time the

invention was made to modify the software updating system with the configuration and system

element information as taught by Smith, and modified to have a first database for one element of

information and another database for other configuration information as taught by Bakshi,

because the combination provides a means to configure various devices with relevant software to

attain desired attributes as taught by Bakshi at column 2, lines 34 – 42 increasing the flexibility

to access multiple sources and increasing the chances of finding the best configuration.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure:

U.S. Patent 6,598,223 to Vrhel, Jr. et al. regarding installation of build-to-order

components in a computer system.

U.S. Patent 6,243,468 to Pearce et al. regarding adapting software to hardware upgrades

incorporating hardware and software IDs.

U.S. Patent Application Publication US2002/0010864 A1 to Safa regarding network

transactions with identification of user's machine by reference to hardware information and

software types.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Lawrence Shrader whose telephone number is (703) 305-8046.

The examiner can normally be reached on M-F 08:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kakali Chaki can be reached on (703) 305-9662. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lawrence Shrader
Examiner
Art Unit 2193

25 May 2005

TODD INGBERG
PRIMARY EXAMINER